

REMARKS

Regarding the 35 USC 103 rejections of independent claims 49 and 54 it is respectfully submitted that there is no fair suggestion in the art of record of combining a frameless eye patch, which carries a corrective optical lens, with an attention getting message or device to invite social interaction and wherein the eye patch is directly affixed to the wearer's face (via an adhesive in claims 41 and 49) to enable the patch carrying its attention getting message to be secured to said face during vigorous social activity such as swimming and dancing. The new and beneficial function (KSR) of using this combination include enhancing social interaction during vigorous activity such as dancing or swimming in particular while providing enhanced eyesight to those feeling self conscious wearing conventional eyeglasses while socializing. In contrast with conventional eyeglass frames like the Mack reference, the eye patch will not be dislodged during such vigorous activities and is inexpensive to make due to its simplicity.

Furthermore, the claimed invention is a method for aiding a person seeking to attract attention at socially interactive events, often involving physical activities, who may be self-conscious about wearing conventional eyeglasses. There simply is no fair suggestion of this teaching in the cited references.

The ordinary skilled worker in the art would understand that the Chunga and Mack references do not suggest applicant's eye patch that has enough area to bear a highly visible message inviting social interaction and yet anchor the mask securely to the wearer's face enabling the wearer to swim and dance for example without losing the eyeglasses.

MPEP 2111.02: When not defined by applicant in the specification, the words of a claim must be given their plain meaning. In other words they must be read as they would be interpreted by those of ordinary skill in the art." The eyeglasses of the Chunga and Mack are simply not eye patches as employed in applicant's method claims .

The primary Craig reference discloses an eye shield that is used to protect the eyes of the patient during surgery and bears no corrective lens or message for enhancing social interaction and thus has nothing to do with applicant's specifically claimed method of enhancing social interaction.

The examiner's statement that Craig could be modified to carry a message as taught by Mack ... "to be provided to the user as a souvenir after surgery" is powerful evidence that this combination is not suggested by the references. The examiner's highly imaginative and highly contrived combination, by its very contrived nature, strongly indicates that the combination is derived solely from applicant's disclosure which is unfair and impermissible.

Patients, hospitals and surgeons to not take surgery lightly and thus writing on a patients eye shield after surgery in the manner of a souvenir would be extremely frivolous and unheard of, to say the least.

Please recall: "It is error to reconstruct the claimed invention from the prior art by using the patentee's claim as a blueprint. When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than hindsight obtained from the invention itself. It is critical to understand the particular results achieved by the new combination (emphasis supplied)", Interconnect Planning Corporation v. Feil, 227 USPO 543 (Federal Circuit 1985)." These particular results indicate the value of the inventor's contribution to the art, that of course is the major goal of the patent system.

The primary reference to Chunga cannot suggest applicant's claimed method because he has no eye patch having a well understood meaning supra and has no room to provide for carrying a socially interactive message during vigorous activity.

The Manual of Patent Examining Procedure (MPEP), sec. 2143, page 2100-122 of the August 2001 Edition states that:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

As argued above there is no suggestion or motivation to combine the references.

Also, there is no reasonable expectation of success in making the combinations (set forth in the method claims) to achieve applicant's clearly stated objective of inviting social interaction by securing the messages upon eye patches during vigorous activity by virtue of using eye patches rather than eyeglasses. The Mack and Chunga eyeglasses would often fall off during vigorous activity. Imagine a person swimming in the ocean with a pair of eyeglasses as shown by Mack or Chinga! Also there can be no expectation of success in making this combination as there is no room on Chenga for receiving a message.

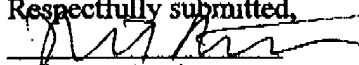
Craig is an eye shield or protector used during surgery to protect the patient from injury, has no corrective lenses and has nothing to do with applicant's objectives set forth by the positive wording of the method claims. Re MPEP 2143: The third criteria of the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Regarding claims 49, and 55, and dependent claims 43 and 44, if an old outdated previously prescribed eyesight corrective lens is affixed to the outer adhesive layer in the preferred method (e.g. claims 43, 44), persons who would not otherwise wear their conventional eyeglasses during dancing or swimming in particular would have enhanced eyesight. An additional new, beneficial, and unobvious use is thus made of an old corrective lens that would otherwise be discarded. It is respectfully submitted that the claimed subject matter constitutes new and beneficial results and new functions not suggested by the cited references. The claimed methods are hardly normal use of the references as stated by the examiner.

Should the examiner still deem the application not in condition for allowance, the examiner is respectfully requested to make any suggestions in a telephonic interview or

otherwise that may further advance prosecution in accordance with the mandate of MPEP 707.07 (j); page 700-101 8th Ed. : "When an application discloses patentable subject matter and it is apparent from the claims and applicant's arguments that the claims are intended to be directed to such patentable subject matter, ...the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and where possible, should offer a definite suggestion for correction." This should in fairness be emphasized after an RCE has been filed as in this application.

Respectfully submitted,


Robert L. Nathans

Registration # 19,558.

978-667-3060; robnathans@aol.com